

2. RESPONSE/REMARKS

2.1 STATUS OF THE CLAIMS

Claims 1, 9-10, 14-15, 27-31, 46-48, 51, 54, and 72-75 were pending at the time of the Action

Claim 28 has been canceled herein without prejudice or disclaimer.

Claims 1, 9-10, 14-15, 27, 29-31, 46-48, 51, 54, and 72-75 have been amended herein.

Claims 76 and 77 have been added herein.

Claims 1, 9-10, 14-15, 27, 29-31, 46-48, 51, 54, and 72-77 are now pending in the RCE.

2.2 SUPPORT FOR THE CLAIMS

Support for the pending claims can be found throughout the original claims, specification and figures as filed. It is Applicants' belief that no new matter is included as a result of the accompanying amendment.

2.3 EXAMINER INTERVIEW SUMMARY (EIS)

Applicants acknowledge the EIS of record for the teleconference between Applicants' undersigned representative, Examiner Hibbert, and Primary Examiner Vogel, conducted with the Office on August 24, 2010. Applicants hereby concur that the substance of the interview (as recorded by Examiner Hibbert in the EIS) concerned improvement to, and clarification of, the claim language for the elected invention. Applicants appreciate the cooperation of the Office in addressing the clarity issues previously of record, and gratefully acknowledge the time taken by Examiners Hibbert and Vogel to participate in the telephonic discussion.

2.4 THE REJECTION OF CLAIMS UNDER 35 U.S.C. § 112 IS OVERCOME.

Claims 1, 9-10, 14-15, 27-31, 46-48, 51, 54, and 72-75 were rejected under 35 U.S.C. § 112, second paragraph, allegedly as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants respectfully traverse.

However, in an attempt to provide even greater clarity to the claims, and to more distinctly point out particular embodiments of the invention, Applicants have amended the claims to more particular claim certain embodiments of the invention. In particular, the claims have been amended to recite “An expression vector...” instead of “An isolated polynucleotide...”, and the term “isolated” has been used to modify the elements recited in the vector to avoid unintentional ambiguity with respect to the native HSV genome, from which several of the genetic elements employed in the construction of the expression vector were obtained. Applicants appreciate the helpful suggestions of Examiner Hibbert and Primary Examiner Vogel during the Office Interview on August 24, 2010 in improving the clarity of these claims, and more distinctly pointing out particular aspects of the claimed invention.

In view of the clarity now provided to these claims, Applicants believe that their request for continuing examination is proper, and timely in view of the present Action, and that the accompanying amendment fully addresses the concerns expressed by the Office as to the clarity of the claims. To that end, Applicants now respectfully request that the indefiniteness rejection be withdrawn for all pending claims.

2.5 THE REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(B) IS OVERCOME.

Claims 1, 9-10, 14-15, 27-31, 46-48, 51, 54, and 72-75 were rejected under 35 U.S.C. § 102(b), allegedly as being anticipated by Coffin and Latchman (PCT Intl. Pat. Appl. Publ. No. WO 98/30707; "Coffin and Latchman").

Applicants respectfully traverse, and remind the Office that a proper rejection on the grounds of anticipation requires the disclosure, in a single reference, of every element of a claimed invention and requires that each and every facet of the claimed invention be identified in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461 (PTO Bd. App. 1990). As stated in the decision of *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990): "(f)or a prior art reference to anticipate in terms of 35 U. S. C. § 102, every element of the claimed invention must be *identically shown in a single reference*" (Emphasis added). As also noted in M.P.E.P. § 2131, [a] claim is anticipated under 35 U.S.C. § 102, if, and only if, each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . (Emphasis added).

Coffin and Latchman is said to disclose recombinant HSV vectors comprising an isolated polynucleotide that comprises each of the elements recited in applicants' independent claims, and is cited as teaching the claimed invention.

Applicants respectfully traverse, and note for the record that Coffin and Latchman does not disclose any expression vectors that comprise an isolated HSV LAT enhancer element; and either first or second isolated LAT insulator/boundary regions that consist essentially of, or alternatively consist of, *a specific contiguous nucleotide sequence from any one of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111*, as now recited in independent claims 1

and 73, and their dependencies.

Similarly, the reference also does not teach or suggest the particular embodiments of the invention as set forth in independent claims 1 and 73 that recite an “expression vector comprising, in 5’ to 3’ order: (a) a first isolated HSV LAT insulator/boundary region that consists essentially of a contiguous nucleotide sequence from about nucleotide 8365 to about nucleotide 9273 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111, operably positioned 5’ of a first nucleic acid segment comprising a selected gene of interest operably linked to a first promoter that expresses the gene in a selected host cell; and (b) a second isolated HSV LAT insulatory/boundary region that consists essentially of a contiguous nucleotide sequence from about nucleotide 120,208 to about nucleotide 120,940 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111, operably positioned 3’ of the first nucleic acid segment,” and an “expression vector comprising, in 5’ to 3’ order: (a) a first isolated HSV LAT insulator/boundary region that consists essentially of a contiguous nucleotide sequence from about nucleotide 8365 to about nucleotide 9273 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111; (b) a first nucleic acid segment comprising a first multiple cloning region operably linked to a first nucleic acid segment comprising a first selected gene of interest operably linked to a first promoter that expresses the first gene of interest in a selected host cell; (c) a first HSV LAT enhancer element operably linked to the first nucleic acid segment, wherein the enhancer element consists essentially of a contiguous nucleotide sequence from about nucleotide 118,975 to about nucleotide 120,471 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111; (d) a second nucleic acid segment comprising a second multiple cloning region operably linked to a second nucleic acid segment comprising a second selected gene of interest operably linked to a second promoter that expresses

the second gene of interest in a selected host cell; and (e) a second isolated HSV LAT insulatory/boundary region that consists essentially of a contiguous nucleotide sequence from about nucleotide 120,208 to about nucleotide 120,940 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111,” respectively.

Because Coffin and Latchman fails to disclose each and every element of the claimed invention, it *cannot* anticipate the claimed invention within the meaning of 35 U. S. C. § 102; thus the present rejection is improper. Thus, for at least the reasons stated above, Applicants respectfully request that the rejection of all pending claims over Coffin and Latchman be reconsidered and withdrawn.

2.6 REQUEST FOR EXAMINER INTERVIEW

Pursuant to M.P.E.P. § 713.01 and 37 C.F.R. § 1.133, Applicants hereby request an interview between the Office and the undersigned representative, should any questions remain unanswered in the mind of Examiner Hibbert, or should any claims remain rejected for any reason following entry of the present amendment and consideration of the remarks and response herein.

In such instance, Applicants respectfully request, pursuant to M.P.E.P. §§ 408 and 713.09, that the Office contacts the undersigned representative, *prior to the issuance of any subsequent action on the merits*, to arrange an Examiner Interview (at a time mutually convenient to the parties) to discuss favorable disposition of the case, or to resolve any remaining issues of record. Applicants’ representative particularly appreciates in advance Examiner Hibbert’s willingness to conduct such an interview within the next sixty days, should one be beneficial to progressing the pending claims to allowance.

2.7 CONCLUSION.

Should the Examiner have any questions, a telephone call to the undersigned Applicants' representative would be appreciated.

Respectfully submitted,



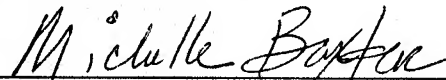
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